

Notice of Allowability

Application No.

10/523,824

Examiner

Michael Bernshteyn

Applicant(s)

YAMAGO ET AL.

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 06/13/2007.
2. ☒ The allowed claim(s) is/are 1,2,4,5 and 10-12.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

Michael Bernshteyn
Patent Examiner
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DETAILED ACTION

1. This Office Action is a response to the remarks filed on June 1, 2007. No claims have been amended or added; claim 3 has been cancelled.
2. In view of the amendment(s) and remarks, the rejection under 35 U.S.C. 112, 1st paragraph and under 35 U.S.C 102(b) of claims 1-4 and 10 and 11 as being anticipated by Kanda et al. have been withdrawn.
3. Claims 1, 2, 4, 10 and 11 are now active.

EXAMINER'S AMENDMENT

4. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mr. Michael R. Davis on June 13, 2007.

5. Claims 6-9 and 13-22 have been cancelled.
6. Claims 5 and 12 have been amended and rejoined with claims 1, 2, 4, 10 and 11. The reason for the rejoining of the claims 5 and 12 is the following.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder.

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All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims has been withdrawn, and the rejoined process claims has been fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant was advised that the process claims should be amended during prosecution to require the limitations of the product claims.

The newly amended claims 5 and 12 contain all the limitations of the allowable product claim 4 for that process invention to be rejoined.

Allowable Subject Matter

7. Claims 1, 2, 4, 5, 10, 11 and 12 are allowed.
8. The following is examiner's statement of reasons for allowance:

The present claims are allowable over the closest references: Kanda et al. ("Generation of allyl- and benzyllithiums from the corresponding halides by the aid of lithium-tellurium exchange reactions", Journal of Organometallic Chemistry, 473 (1994), 71-83).

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Kanda discloses a variety of allyl- and benzyllithiums, which were prepared by lithium-tellurium exchange reactions of allylic and benzylic tellurides generated in situ from the corresponding halides (abstract).

Kanda discloses the reactions of benzylic tellurides having bromo and iodo substituents with organolithium reagents (page 74, Table 2).

TABLE 2. Reactions of benzylic tellurides having bromo and iodo substituents with organolithium reagents

2 (Z = Br, I)		23	24	25	26	27	28				
Run	telluride 2	RLi	temp(°)	solvent	gls(isolated) yields of products (%)						
					23	24	25	26	27	28	^a BuTeR
1		^a BuLi	-70	THF	(44) ^a	0	9	(33)	0	6	(55)
2		^a BuLi	-70	Et ₂ O	79(68) ^a	0	2	0	0	< 1	70
3		^a BuLi	-70	THF	(42)	0	0	(17)	0	0	(51)
4		^a BuLi	-70	Et ₂ O	81(75)	0	2	0	0	< 1	82
5		^a BuLi	-70	THF	(32)	0	6	(14)	0	5	(47)
6		^a BuLi	-70	Et ₂ O	63(53)	0	6	2	0	8	76
7		^a BuLi	-70	THF	5	28	0	0	51	0	(30)
8		^a BuLi	-105	Et ₂ O	21	3	3	< 1	32	0	23
9		MeLi	-105	Et ₂ O	49	0	3	0	39	0	- ^b
10		PhLi	-105	Et ₂ O	46	0	0	9	32 ^c	< 1	51

Conditions: benzylic tellurides 2 were prepared in THF (5 ml) from 1 (2 mmol), tellurium (2 mmol) and butyllithium (2 mmol, 1.6 M in hexane) and used without isolation. The exchange reactions were conducted using RLi (2 mmol) at the temperature indicated for 15 min and quenched with butanal (2 mmol). The solution was warmed to room temperature, washed with saturated NH₄Cl_{sat}, and the resulting mixture was analyzed by glc and/or NMR. Yields of 24, 26 and 27 are based on RLi used, and that of 28 on 2. ^a The product 23i in runs 1 and 2 is the same as 12. ^b Not determined. ^c NMR yield.

Therefore, benzylic telluride compounds (telluride 2) correspond to the claimed formulas (1), (4), (5) and (6), wherein R¹=n-Bu, R² and R³ = H, and R⁴ = aryl or substituted aryl.

However, Kanda et al. does not disclose or suggest an organotellurium compound represented by formulas (1), (4), (5) and (6), wherein R² and R³ are not simultaneously a hydrogen atom, as in instant claims 1, 4, 10 and 11.

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9. As of the date of this Notice of Allowability, the Examiner has not located or identified any reference that can be used singularly or in combination with another reference including Kanda et al. to render the present invention anticipated or obvious to one of ordinary skill in the art.

10. In the light of the above discussion, it is evident as to why the present claims are patentable over the prior art.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delay, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reason for Allowance".

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bernshteyn whose telephone number is 571-272-2411. The examiner can normally be reached on M-F 8-5:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Bernshteyn
Patent Examiner
Art Unit 1713

MB
06/18/2007


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